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OFFICE OF PETITIONS

In re Application of	:	
GANESAN et al.	:	
Application No. 09/849,979	:	DECISION ON APPLICATION
Filed: May 8, 2001	:	FOR
Atty. Docket No. 23952-0127	:	PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR PATENT TERM ADJUSTMENT RECONSIDERATION," filed December 14, 2007. Applicants request correction of the patent term adjustment from 502 days to 1,012 days partly on the basis of the Office taking in excess of three years to issue the patent.

The application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct patent term adjustment determination at the time of the mailing of the notice of allowance is **572 days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within three years. See 37 CFR 1.703(b).

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.¹

On September 14, 2007, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants were advised that the patent term adjustment to date is 502 days. In response, applicants timely² filed the instant request for reconsideration of the patent term adjustment. Applicants request that the patent term adjustment be corrected to 1,012 days. Applicants dispute the reduction pursuant to 37 CFR 1.704(b) of 71 days. Further, applicants assert that the Office's delay pursuant to 37 CFR 1.703(e) should be calculated as 590 days, not 591 days.

The application history has been reviewed and it has been determined that the initial patent term adjustment of 502 days is incorrect. The Office mailed a nonfinal Office action on August 19, 2003. However, the Office action was not mailed to the correspondence address of record. The record supports a conclusion that this was due to an error on the part of the Office in mailing the nonfinal Office action to applicants. Accordingly, a letter restarting the period for reply (and re-mailing the Office action) was mailed on October 29, 2003. Applicants' response filed January 29, 2004, was received within the three-month period after the date of the mailing of the Office action as re-mailed on October 29, 2003. Accordingly, a period of reduction of 71 days is not warranted.

¹ Applicants' assertion that the patent term adjustment should be reduced for filing amendments on February 27, 2007, and May 3, 2007, after the mailing of the notice of allowance under 37 CFR 1.704(c)(10) is premature and will not be addressed in the present petition under 37 CFR 1.705(b).

² Office records indicate that the issue fee payment was received on December 14, 2007.

Additionally, applicants aver that the Office's delay pursuant to 37 CFR 1.703(e) should be calculated as 590 days, not 591 days. Applicants assert that the calculation of patent term adjustment was calculated using March 1, 2006, as the date of the final decision by the Board of Patent Appeals and Interferences instead of February 28, 2006. The record supports applicants' assertion that the Decision on Appeal was mailed on February 28, 2006. Thus, the period of adjustment pursuant to 37 CFR 1.703(e) is 590 days, the number of days beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed, July 19, 2004, and ending on the date of a final decision in favor of applicants by the Board of Patent Appeals and Interference, February 28, 2006.

In view thereof, the patent term adjustment at the time of the mailing of the Notice of Allowance is **572 days** (605 days of Office delay - 33 days of applicant delay).

Applicants are reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than three years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

Kery A. Fries

Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of updated PAIR screen

Day : Sunday
 Date: 7/20/2008

Time: 09:31:47

PALM INTRANET

PTA Calculations for Application: 09/849979					
Application Filing Date:		05/08/2001	PTO Delay (PTO):		606
Issue Date of Patent:			Three Years:		0
Pre-Issue Petitions:		0	Applicant Delay (APPL):		104
Post-Issue Petitions:		0	Total PTA (days):		572
PTO Delay Adjustment:		70			
File Contents History					
Number	Date	Contents Description		PTO	APPL
134	07/20/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		70	
124	09/14/2007	MAIL NOTICE OF ALLOWANCE			
123	09/05/2007	CORRESPONDENCE ADDRESS CHANGE			
122	08/30/2007	ISSUE REVISION COMPLETED			
121	08/30/2007	DOCUMENT VERIFICATION			
120	08/30/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
119	08/30/2007	NOTICE OF ALLOWABILITY			
118	07/19/2007	DATE FORWARDED TO EXAMINER			
117	07/13/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
116	07/19/2007	DATE FORWARDED TO EXAMINER			
115	07/13/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
114	07/19/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
113	07/16/2007	MAIL-RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			
112	07/13/2007	PETITION ENTERED			
111	07/13/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
110	07/13/2007	WORKFLOW - QUERY REQUEST - FINISH			
109	07/12/2007	MAIL RESPONSE TO 312 AMENDMENT (PTO-271)			
108	07/11/2007	RESPONSE TO AMENDMENT UNDER RULE 312			
107	05/03/2007	AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312)			
106	05/15/2007	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			

105	05/15/2007	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
104	05/02/2007	WORKFLOW - QUERY REQUEST - BEGIN			
103	04/20/2007	EXPORT TO FINAL DATA CAPTURE			
102	04/19/2007	DISPATCH TO FDC			
101	04/12/2007	MAIL RESPONSE TO 312 AMENDMENT (PTO-271)			
100	04/11/2007	RESPONSE TO AMENDMENT UNDER RULE 312			
99	02/27/2007	RESPONSE TO REASONS FOR ALLOWANCE			
98	02/27/2007	AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312)			
97	02/28/2007	APPLICATION IS CONSIDERED READY FOR ISSUE			
96	02/27/2007	ISSUE FEE PAYMENT VERIFIED			
95	02/27/2007	WORKFLOW - DRAWINGS FINISHED			
94	02/27/2007	ISSUE FEE PAYMENT RECEIVED			
93	01/26/2007	FINISHED INITIAL DATA CAPTURE			
92	12/01/2006	EXPORT TO INITIAL DATA CAPTURE			
91	11/27/2006	MAIL NOTICE OF ALLOWANCE			
90	11/27/2006	MAIL FORMAL DRAWINGS REQUIRED			
89	11/27/2006	MAIL EXAMINER INTERVIEW SUMMARY (PTOL-413)			
88	11/27/2006	MAIL EXAMINER'S AMENDMENT			
87	11/25/2006	CORRECTED FILING RECEIPT			
86	11/25/2006	EXAMINER'S AMENDMENT COMMUNICATION			
85	11/25/2006	ISSUE REVISION COMPLETED			
84	11/25/2006	FORMAL DRAWINGS REQUIRED			
83	11/25/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
82	11/25/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
81	02/17/2005	MISCELLANEOUS INCOMING LETTER			
80	11/25/2002	NEW OR ADDITIONAL DRAWING FILED			
79	04/09/2002	MISCELLANEOUS INCOMING LETTER			
78	07/13/2001	MISCELLANEOUS INCOMING LETTER			
77	07/13/2001	SUBSTITUTE SPECIFICATION FILED			
76	07/13/2001	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
75	07/13/2001	NEW OR ADDITIONAL DRAWING FILED			

74	05/08/2001	PRELIMINARY AMENDMENT			
73	11/21/2006	NOTICE OF ALLOWABILITY			
72	11/16/2006	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
71	09/27/2006	DATE FORWARDED TO EXAMINER			
70	09/11/2006	RESPONSE AFTER NON-FINAL ACTION			
69	08/04/2006	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
68	07/26/2006	MISCELLANEOUS ACTION WITH SSP			
67	03/09/2006	CASE DOCKETED TO EXAMINER IN GAU			
66	03/01/2006	MAIL BPAI DECISION ON APPEAL - AFFIRMED IN PART	591		47
65	02/28/2006	BPAI DECISION - EXAMINER AFFIRMED IN PART			
64	01/09/2006	MISCELLANEOUS INCOMING LETTER			
63	01/09/2006	MISCELLANEOUS INCOMING LETTER			
62	01/09/2006	CONFIRMATION OF HEARING BY APPELLANT			
61	09/28/2005	DOCKETING NOTICE MAILED TO APPELLANT			
60	09/28/2005	ASSIGNMENT OF APPEAL NUMBER			
59	09/19/2005	CORRESPONDENCE ADDRESS CHANGE			
58	09/20/2005	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
57	08/03/2005	APPEAL AWAITING BPAI DOCKETING			
56	05/18/2005	MAIL REPLY BRIEF NOTED BY EXAMINER			
55	05/16/2005	REPLY BRIEF NOTED BY EXAMINER			
54	02/15/2005	REQUEST FOR ORAL HEARING			
53	03/03/2005	DATE FORWARDED TO EXAMINER			
52	02/15/2005	REPLY BRIEF FILED			
51	12/16/2004	MAIL EXAMINER'S ANSWER			
50	12/13/2004	EXAMINER'S ANSWER TO APPEAL BRIEF			
49	09/23/2004	DATE FORWARDED TO EXAMINER			
48	09/20/2004	APPEAL BRIEF FILED			
47	07/19/2004	NOTICE OF APPEAL FILED			
46	07/15/2004	MAIL ADVISORY ACTION (PTOL - 303)			
45	07/14/2004	ADVISORY ACTION (PTOL-303)			
44	07/02/2004	DATE FORWARDED TO EXAMINER			
43	06/21/2004	AMENDMENT AFTER FINAL REJECTION			
42	04/19/2004	MAIL FINAL REJECTION (PTOL - 326)			
41	04/19/2004	FINAL REJECTION			

40	02/11/2004	DATE FORWARDED TO EXAMINER			
39	01/29/2004	RESPONSE AFTER NON-FINAL ACTION	71	28	
38.7	11/24/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
38	11/24/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
36	11/10/2003	CASE DOCKETED TO EXAMINER IN GAU			
35	10/29/2003	MAIL NOTICE OF RESTARTED RESPONSE PERIOD			
34	10/29/2003	LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES)			
33	09/25/2003	MISCELLANEOUS INCOMING LETTER			
32	10/07/2003	CASE DOCKETED TO EXAMINER IN GAU			
31	09/09/2003	CORRESPONDENCE ADDRESS CHANGE			
30	09/10/2003	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
29	09/09/2003	CORRESPONDENCE ADDRESS CHANGE			
28	08/19/2003	MAIL NON-FINAL REJECTION			
27	08/11/2003	NON-FINAL REJECTION			
26	06/04/2003	DATE FORWARDED TO EXAMINER			
25	05/23/2003	RESPONSE AFTER NON-FINAL ACTION			
24	02/27/2003	MAIL NON-FINAL REJECTION			
23	02/24/2003	NON-FINAL REJECTION			
22	11/25/2002	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
21	11/25/2002	SUBSTITUTE SPECIFICATION FILED			
20	12/18/2002	DATE FORWARDED TO EXAMINER			
19	11/25/2002	RESPONSE AFTER NON-FINAL ACTION	33	14	
18	11/25/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			
17	11/25/2002	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
16	11/15/2002	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
15	11/15/2002	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
14	07/23/2002	MAIL NON-FINAL REJECTION	15	-1	
13	07/12/2002	PRELIMINARY AMENDMENT			
12	06/03/2002	NON-FINAL REJECTION			
11	04/23/2002	CASE DOCKETED TO EXAMINER IN GAU			

10	05/08/2001	PRELIMINARY AMENDMENT			
9	10/30/2001	CASE DOCKETED TO EXAMINER IN GAU			
8	09/24/2001	APPLICATION DISPATCHED FROM OIPE			
7	06/04/2001	APPLICATION IS NOW COMPLETE			
6	06/04/2001	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
5	06/04/2001	CORRESPONDENCE ADDRESS CHANGE			
4	06/04/2001	CORRESPONDENCE ADDRESS CHANGE			
3	06/01/2001	CORRESPONDENCE ADDRESS CHANGE			
2	05/16/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	05/08/2001	INITIAL EXAM TEAM NN			

Search Another: Application#

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to [OASIS](#) | Home page